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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/833,169	04/11/2001	Andrew G. Lee	PC10636ATMC	1529
7590 07/01/2004			EXAMINER	
Gregg C. Benson Pfizer Inc. Patent Department, MS 4159 Eastern Point Road Groton, CT 06340			WEBMAN, EDWARD J	
			ART UNIT	PAPER NUMBER
			1617	
DATE MAILED: 07/01/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.



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09/833169

APPLICATION NUMBER	FILED DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
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EXAMINER
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ART UNIT	PAPER NUMBER
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5/30/04

DATE MAILED:

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

### OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 3/22/04

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

### Disposition of Claims

- ☒ Claim(s) 1-5, 10-12, 40-43 is/are pending in the application.  
Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☒ Claim(s) 10-12 is/are allowed.
- ☒ Claim(s) 1-4, 40-44 is/are rejected.
- ☒ Claim(s) 45-53 is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

~~Claim 1 is rejected under 35 U.S.C. 102(e) because the applicant did not invent the claimed subject matter. \*\*\*.~~

Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Place et al.

Place et al teach a composition for treating sexual dysfunction. Estrogen antagonists including Tamoxifen, Raloxifene, and Cenchroman are disclosed (column 8 lines 27-35, 49-53).

Applicants argue CGMP, however, it is merely optional.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-4, 40-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Place et al.

Place is discussed above.

As to the particular claimed compounds, applicants disclose them all as serms,  
synonymous with older terminology "Estrogen Antagonist" (Halonen et al col.1 lines 40-  
42).

It would have been obvious to one of ordinary skill to use the claimed compounds  
in the method of Place et al in view of their known function as estrogen antagonists as  
stipulated by applicants.

No criticality has been shown for any particular claimed compound.

In re Boesch 205 USPQ 215 (CCPA 1980).

Claims 10-12 are allowed.

Claims 1-4, 40-44 are rejected.

Claims 45-53 are objected to as being dependent upon a rejected base claim,  
but would be allowable if rewritten in independent form including all of the limitations of  
the base claim and any intervening claims.

Any inquiry concerning this communication should be directed to Edward J.  
Webman at telephone number 571-272-0633.

Webman/tgd

June 7, 2004

